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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/066,205 | 06/27/2002 | Thomas E. Dungan | DTE-101-C | 5321 |

7590 08/29/2003

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EXAMINER

FARAH, AHMED M

ART UNIT

PAPER NUMBER

3739

DATE MAILED: 08/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/066,205

Applicant(s)
Thomas E. Dungan

Examiner
Ahmed M. Farah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Feb 5, 2002 is/are a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities:
 - i. Page 7, paragraph 2, line 7, the radiation source “12” is not shown in the Figures. Correction, such as radiation source --22-- is suggested.
 - ii. Page 7, paragraph 5 (last ¶), line 2, the recitation “bulb 23 22” is not shown in the Figures. Correction is required.
 - iii. Page 8, lines 1, 2, 4, and 21; page 9, line 2; and page 10, line 15, the recitation “bulb 23” is not shown in the Figures. Correction, such as --bulb 22-- , or a correction to the drawings to include a reference character --23-- designated for a light bulb is suggested.
 - iv. Page 9, paragraph 3, line 2, the term “means” in the second instance (after the reference character 72) is believed to be a typographical error. Correction is required.
 - v. Page 9, paragraph 4, line 2, the recitation “transformer 78” is not in line with the teaching of the drawings. Correction, such as --transformer 70-- is suggested.
 - vi. Page 11, paragraph 2, lines 4-5, the phrase “... and surrounds the light bulb 46” is not a correct and/or a complete description of the device. Correction, such as --and surrounds the forward end 48 of the light bulb 22-- is suggested.

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- vii. Page 12, paragraph 3, line 3, the term "transformer 80" is not in line with the teaching of the drawings. Correction, such as --transformer 70-- is suggested.

Drawings

- 2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show:
 - i. a **resonance coil 38** as described in the specification (page 8, line 23 (¶ 4, line 3); and page 13, line 1); and
 - ii. a **recess 61** as described in the specification (page 11, line 7 and Fig. 3).

Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application.

- 3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the **resonance coil 38** must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

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Claim Objections

4. Claim 1 and 4 are objected to because of the following informalities: in claim 1, line 22, and claim 4, lines 1-2, the applicant recites "means to regulate the power." It is not clear to the examiner whether the applicant wants to invoke the 35 U.S.C. 112, sixth paragraph.

Applicants have an opportunity and obligation to define their inventions precisely during proceedings before the PTO. They are required to specify their inventions, consistent with the guidelines described in MPEP 2181, when a claim limitation invokes 35 U.S.C. 112, sixth paragraph.

A claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase "means for" or "step for";*
- (B) the "means for" or "step for" must be modified by functional language; and*
- (c) the phrase "means for" or "step for" must not be modified by sufficient structure, material or acts for achieving the specified function.*

If an applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant must either: (A) amend the claim to include the phrase "means for" or "step for" in accordance with these guidelines; or (B) show that even though the phrase "means for" or "step for" is not used, the claim limitation is written as a function to be performed and does not recite sufficient structure, material, or acts which would preclude application of 35 U.S.C. 112, sixth paragraph. See *Watts v. XL Systems, Inc.*, 232 F.3d 877, 56 USPQ2d 1836 (Fed. Cir. 2000). Clarification is required.

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5. Claim 6 is objected to because of the following informalities: claim 6 contains more than one sentence. Each claim begins with a capital letter and ends with a period. Periods may not be used elsewhere in the claims except for abbreviations. See *Fressola v. Manbeck*, 36 USPQ2d 1211 (D.D.C. 1995). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation, 37 CFR 1.75(I). Appropriate correction is required.

Double Patenting

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A **statutory type** (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. Claims 7-14 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 7-14 of prior U.S. Patent No. 5,591,219. This is a double patenting rejection.

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8. **The nonstatutory** double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 5,591,219 to Dungan.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed to analogous therapeutic devices, except that the claims of the present application recite plurality of lens modules, rather than the single lens module of the U.S. Patent.

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However, Dungan ('219) teaches that a plurality of different lenses may be used with the device so as to apply different wavelengths of light to the treatment area (see lines 4-5 of the abstract). As to the limitation "each lens module having a color corresponding to a Shakra energy center" in the claims of the instant application, Dungan ('219) teaches that the lens modules may have different colors such as red, white, blue, green, orange, purple, or yellow (see Col. 5, lines 36-38).

In this Office Action, the "Shakra energy" or 'Chakra energy' is defined as 'one of the seven centers of spiritual energy/colors in the human body according to oriental/yoga philosophy¹.' Furthermore, 'Shakra' or 'Chakra' colors are defined as seven colors such as red, orange, yellow, green, blue, indigo, and purple (see <http://www.geocities.com/CapeCanaveral/8430/spirit.htm>).

Therefore, it would have been obvious to one skilled in the art to use different-color lens modules in order to vary the wavelength of the light applied to treatment site as suggested by Dungan ('219). The use of different color lens would provide treatment energies suitable for different tissue/skin conditions (see Col. 5, line 66 to Col. 6, line 5 of Dungan).

¹ The American Heritage® Dictionary of the English Language, Third Edition copyright © 1992 by

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Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 7-14 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Dungan U.S. Patent No. 5,591,219.

Dungan discloses an analogous therapeutic device comprising all the limitations of the instant claims. See claims 7-14 of Dungan.

12. Claims 1-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dungan U.S. Patent No. 5,591,219.

Dungan discloses a therapeutic radiation device as claimed, the device comprising all of the limitations of the instant claims, including a plurality of different/interchangeable lens modules, each lens module having a plurality of "silicon and diamond granules." He further teaches that the lens modules have different colors so as to vary the wavelengths of the light/radiation applied to the treatment areas (see the abstract).

As to the recitation '**each lens module having a color corresponding to a Shakra energy center**' in the claims, the lens modules of Dungan have different colors such as red, orange, yellow, green, blue, purple, white, or any other color that is translucent (see Col. 5, lines

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36-38). In this Office Action, as described in page 6 above, 'Shakra/Chakra energy center' is treated/defined as any one of seven colors such as red, orange, yellow, green, blue, indigo, and purple. Hence, it is the examiner's position that the colors of the lens modules disclosed by Dungan anticipate this limitation. That is, the colors of the lens modules of Dungan coincide with the colors of Shakra/Chakra energy centers.

As to the recitation "silicon dioxide" in claim 1, although Dungan does not particularly mention silicon dioxide (SiO_2), he clearly teaches that the silicon granules in his lens are, preferably, **sand** (see Col. 5, line 18). It is known that **sand** can be defined as 'grains or particles of disintegrated siliceous rock, chiefly of quartz'.² It is also known that SiO_2 (known as silica), is 'a white or colorless crystalline compound, occurring abundantly as **quartz**, **sand**, flint, agate, and many other minerals'.¹ Therefore, the examiner's position is that since sand comprises silicon dioxide, the lenses of Dungan inherently comprise silicone dioxide granules as presently claimed.

² Hackh's Chemical Dictionary, Third Edition, Copyright ©1944, by the McGraw-Hill Book Company, Inc.

¹ The American Heritage® Dictionary of the English Language, Third Edition copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation.

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Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the following references:

U.S. Patent No. 6,347,238 B1 to Levengood et al. discloses apparatus and method for objectively evaluating and treating pain. They teach a method for altering the strength of particular Chakra energy sites in a human body by electromagnetic irradiation. See claim 7; Figs. 5, 5A, and 6; and Col. 9, lines 44-60.

U.S. Patent No. 6,302,900 B1 to Riggs discloses therapeutic laser methods for treating body tissue in problematic area, the treatment including the step of irradiating Chakra energy centers as defined in Eastern medicine. See Fig. 5 and Col. 4, lines 3-6.

U.S. Patent No. 6,500,198 B1 to Southard discloses a therapeutic light emitting device comprising: a tubular housing containing a light source; and a quartz sphere/lens rotatably fixed at the tip of the device for applying therapeutic energy to the skin of a patient.

U.S. Patent No. 5,348,552 to Nakajima et al. disclose a surgical laser system comprising an operating lens 12 made of quartz glass with a hydroxyl material for applying electromagnetic energy to a treatment site. See Figs. 1, 2, and 6-9.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Farah whose telephone number is (703) 305-5787. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak, can be

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reached on (703) 308-0994. The official fax number for the group is (703) 872-9302; and the fax number for After Final is (703) 872-9303.

A. M. Farah

Patent Examiner (Art Unit 3739)

A handwritten signature in black ink, appearing to read 'A. M. Farah', written over the printed name.

July 22, 2003